



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/603,144

06/23/2000

Gregory Jones

5053-28000

1593

7590
Eric B Meyertons
Conley Rose & Tayon PC
PO Box 398
Austin, TX 78767-0398

01/17/2007

EXAMINER

FRENEL, VANEL

ART UNIT

PAPER NUMBER

3627

MAIL DATE

DELIVERY MODE

01/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/603,144

Applicant(s)

JONES ET AL.

Examiner

Vanel Frenel

Art Unit

3626

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 41,42,44,45,47,48,50,52,53,55-60,62,64,65,67-71 and 75.
Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER

See Continuation Sheet of 11: Applicant's arguments filed on 6/15/06 with respect to claims 41,42,44,45,47,48,50,52,53,55-60,62,64,65,67-71 and 75 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed on 6/15/06.

(A) At pages 2-8 of the 6/15/06 response, Applicant argues the followings:

(i) The claims are not obvious over Johnson in view of Reid in view of Myers Pursuant to 35 U.S.C. 103 (a) and Reid and Myers do not appear to teach or suggest at least the features of claim 41.

(ii) Reid does not appear to teach or suggest wherein each of a plurality of business rules in a template table is classified into one of the rule styles, the syntax for a premise and a resulting rule action for a given rule style being common to business rules within the rule style with respect to claims 47 and 59.

(iii) Myers does not appear to teach or suggest a text table comprising a plurality of rows, each of the rows comprising a text string specifying a syntax for one of the business rules.

(iv) The office Action should consider Applicant's claims language in the context in which it appears in the claim, rather than isolation and for example, Myers does not appear to teach or suggest using rules style for a row in a rules data table as a key to find a matching record in the template table and combining business rules data elements for the row in a rules data table and the syntax for a rules style specified in a template table and a text string of the text table to form a business rule.

(v) Reid and Meyers do not appear to mention bodily injury insurance claims. The Office Action does not make reference to any portion of the cited art with respect to the above feature.

(B) With respect to Applicant's first argument, Examiner respectfully submitted that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention.

Rather, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertzner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

(i) obviousness does not require absolute predictability;

(ii) non-preferred embodiments of prior art must also be considered; and

(iii) the question is not express teaching of references, but what they would suggest. Others arguments presented appear to rehash issues addressed in the Finality Rejection of the 6/15/06.

Regarding the features of claim 41, Examiner respectfully submitted that Reid does disclose business objects which can compare to "business rules" that Applicant's is referring to. Furthermore, at column 27, Reid does teach the feature of template record from which Applicant's argued (See Reid, Col.27, lines 13-20). Therefore, Applicant's argument is not persuasive and the finality is hereby sustained.

(C) With respect to Applicant's second argument, Examiner respectfully submitted that He relied upon the clear and unmistakable teaching of Reid whom discloses the features of syntax and premise that Applicant's is referring to. For example Reid teaches a triggers which can manipulate the operations (i.e, business rules) that Applicant's is referring to (See Reid, Fig.16, Col.30, lines 36-54). Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.

(D) With respect to Applicant's third argument, Examiner respectfully submitted that He relied upon the clear and unmistakable teaching of Reid whom suggested: "the features of rows and text string that Applicant's is referring to (See Reid, Col.9, lines 27-35). Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.

(E) With respect to Applicant's fourth argument, Examiner respectfully submitted that He relied upon the clear and unmistakable teaching of Reid whom suggested: "Reid does disclose business objects which can compare to "business rules" that Applicant's is referring to. Furthermore, at column 27, Reid does teach the feature of template record from which Applicant's argued (See Reid, Col.27, lines 13-20). Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.

(F) With respect to Applicant's fifth argument, Examiner

respectfully submitted that this particular limitation has already been

addressed in the previous Office Action, and incorporated herein. Applicant's remaining arguments rely upon those arguments addressed above, and are likewise moot for the same reasons set forth in the preceding responses and the finality is hereby sustained. Others arguments presented appear to rehash issues addressed in the Final Rejection of 11/28/05. Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.